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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/772,384	01/29/2001	Thomas R. Hull	10432-51	1187

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EXAMINER

POON, KING Y

ART UNIT PAPER NUMBER

2624

DATE MAILED: 09/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/772,384

Applicant(s)

HULL, THOMAS R.

Examiner

King Y. Poon

Art Unit

2624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Objections

1. Claims 1, and 5 are objected to because of the following informalities: the phrase "or the ordered media" of claim 1, line 12 and claim 5, line 12 appears to be "of the ordered media." Appropriate correction is required.

Claim Rejections - 35 USC § 102

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 4, 5, 7 are rejected under 35 U.S.C. 102(e) as being anticipated by Newell, Jr. et al (US 6,249,666).

Regarding claim 1: Newell teaches a printing system (fig. 1) comprising: a first input source (e.g., 104, column 3, lines 4-5) to store a first medium (paper, column 3, lines 4-15); a second input source (e.g., 106, column 3, lines 4-5) to store at least one set of an ordered media (each media is given a number or path ID, table 1, column 4, column 5, lines 1-10), the set of ordered media comprising a plurality of sheets having different physical characteristics (column 3, lines 5-10); a user interface (the device that allows the paper handling controller to be programmed, or the device that would allow a user to enter parameter of a print request, column 5, lines 15-30, column 3, lines 20-39) having an input device (inherent properties of a device that take information from human) to select a first part of the ordered media set to be used in a print job (e.g., a

folding print job, column 5, lines 19-20, column 3, lines 23) and a second unwanted part (e.g., shredder, column 3, line 39; note; the sheet of paper that goes to a shredder is unwanted) of the ordered media to be discarded; a job output (e.g., paper folder, column 3, lines 20-25); a shredder connected to the printing system (fig. 1, column 3, lines 20-38); and a central processing unit (micro-controller, column 3, lines 55-58) configured to send the print job (the folding print job) to receive input from the user interface (e.g., the print job is receiving instruction of passing through the print engine, 140, table I, column 4) and send the first part of the ordered media to the job output and the second part of the ordered media to the shredder (the controller is controlling the path of each paper of the ordered media, column 3, lines 50-67, column 4, including to an output device that is a shredder, column 3, lines 35-40).

Regarding claim 4: Newell teaches wherein the ordered media comprises tabs (column 3, lines 30-35).

Regarding claim 5: Newell teaches a method of printing a print job including ordered media (each media is given a number or path ID, table 1, column 4, column 5, lines 1-10) in a printing system (fig. 1) comprising: storing at least one set of an ordered media (each media is given a number or path ID, table 1, column 4, column 5, lines 1-10), the set of ordered media comprising a plurality of sheets having different physical characteristics (column 3, lines 5-10); providing a shredder (column 3, lines 20-40) in the printing system; providing an automated path (table 1, column 4) in the printing system for selected sheets (the path are for each sheet of media, column 5, lines 1-10) of ordered media to travel to the shredder (output device, table 1, column 4, column

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3, lines 20-40); using an interface (the device that allows the paper handling controller to be programmed, or the device that would allow a user to enter parameter of a print request, column 5, lines 15-30, column 3, lines 20-39) on the printing system, selecting a first part of the ordered media set to be used in a print job (e.g., a folding print job, column 5, lines 19-20, column 3, lines 23) and a second unwanted part (e.g., shredder, column 3, line 39; note; the sheet of paper that goes to a shredder is unwanted) of the ordered media to be discarded; configuring the printing system (through user input and program, column 3, lines 50-58, column 5, lines 20-30) to send the first part of the ordered media to the job output (e.g., to a paper sorter, column 3, lines 20-30) and the second part of the ordered media to the shredder (the controller is controlling the path of each paper of the ordered media, column 3, lines 50-67, column 4, including to an output device that is a shredder, column 3, lines 35-40) in response to input on the interface.

Regarding claim 7: Newell teaches comprising using tabs (column 3, lines 30-35) as the ordered media.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claims 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Newell, Jr. et al (US 6,249,666) as applied to claim 1 above, and further in view of Lahey et al. (US 5,999,945).

Regarding claim 2: Although it is well known in the art to use a graphical user interface for allowing users to enter information in most computer application, and Newell's user input console (column 5, line 27) most likely comprises a graphical user interface, Newell does not specifically mention a graphical user interface.

However, Lahey in the same area of programming print jobs, teaches the input device comprises a graphical user interface (column 7, lines 45-60).

Therefore, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Newell's user's input console to include: a graphical user interface.

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Newell's user's input console by the teaching of Lahey because it would allow users to see what he is doing while entering print job information into the system to avoid error.

5. Claims 3, 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Newell, Jr. et al (US 6,249,666) as applied to claim 1 above, and further in view of Masuda (US 4,561,765).

Regarding claims 3, 6: Newell does not teach providing an indication when the shredder is full.

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However, Masuda in the same area of shredder, teaches to provide users an indication when the shredder is full (column 7, lines 43-55, column 9, lines 35-45).

Therefore, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Newell's user's input console to include: an indication when the shredder is full.

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Newell's user's input console by the teaching of Lahey because it would have warned users that the shredder is full and it is time to empty the shredder to avoid system break down.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to King Y. Poon whose telephone number is (703) 305-0892.

9/3/04

A handwritten signature in black ink, appearing to read "King Y. Poon". The signature is fluid and cursive, with the first name "King" and last name "Poon" clearly distinguishable.

**KING Y. POON
PRIMARY EXAMINER**